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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,625	05/08/2001	Rajasekhar Sistla	P10212	3678
50890	7590	11/28/2007		
CAVEN & AGHEVLI c/o INTELLEVATE P.O. BOX 52050 MINNEAPOLIS, MN 55402			EXAMINER TRUONG, LAN DAI T	
			ART UNIT 2152	PAPER NUMBER
			MAIL DATE 11/28/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/851,625

Applicant(s)

SISTLA, RAJASEKHAR

Examiner

Lan-Dai Thi Truong

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/19/2007 has been entered.

2. This action is response to communications: application, filed on 03/08/2001; amendment filed 09/19/2007. Claims 1-21 are pending; claims 1, 6, 11 and 17 are amended

3. The applicant's arguments filed on 09/19/2007 have fully considered; but new scopes of amended claims are moot in view with new ground for rejections

### **Claim rejections-35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 5, 8, 14 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter (i.e. "confidentiality-level-dependent control signal") which was not described in the specification in

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such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The appropriate corrections are required

### **Claim rejections-35 USC § 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 17-21 are rejected under 35 U.S.C. 101 because “a machine readable medium” comprising (i.e., a carrier wave), see (the specification, page 5, paragraph [0014]). The carrier wave is not statutory class because a carrier wave is a signal, which is not a method, a machine, an articles of manufacture or composition of matter, see (MPEP Rule 2107.02)

### **Claim rejections-35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 4-8, 11, 16-17, 20-21 are rejected under 35 U.S.C 103(a) as being un-patentable over Chaudhari et al. (U.S. 7,039,951) in view of Leonard et al. (U.S. 6,721,784) and further in view of Spraggs (U.S. 6,941,454)**

**Regarding claim 1:**

Chaudhari discloses the invention substantially as claimed, including a method, which can be implemented in a computer hardware or software code for preserving confidentiality of an electronic mail from a sender to a recipient, comprising:

authenticating identity information of the recipient: (Chaudhari discloses a method for providing confidence based authentication; whereby users are controlled access to secured data having various levels by scoring/ and validating users provided identities: column 2, lines 60-67; abstract)

establishing confidentiality levels for mail senders: (Chaudhari discloses method for establishing confidential levels for email recipients so that the mailing system can be able to calculate/ and determine if recipients are authorized to read the emails those stored in a secured database based on assigned confidential levels: column 5, lines 1-67; column 8, lines 1-40; column 9, lines 32-34)

However, Chaudhari does not explicitly disclose step of restricting the recipient's ability to manipulate contents of the electronic mail

In analogous art, Leonard disclosed mail senders can limit mail viewers to manipulate email messages e.g. forwarding, printing, see (figure 5, items 330; figure 14, items 27, 29; column 11, lines 25-29; column 12, lines 25-40; column 9, lines 46-50)

Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Leonard's ideas of limiting mail viewers to manipulate email messages e.g. forwarding, printing into Chaudhari's's system in order to increase secure level for privacy information protection in mailing system, see (column 4, lines 50-67)

However, Leonard- Chaudhari does not explicitly disclose encrypting the electronic mail, at the recipient, with the authentication identity information if the recipient attempts to store the electronic mail to local storage

In comparable art, Spraggs discloses “a server” which is equivalent in functionality with the recipient as claimed receives encrypted “data” which is equivalent to electronic mail as claimed from the sending client, and re-encrypts the decrypted data for storing in secure database, see (column 3, lines 45-50; figure 6)

and decrypting the electronic mail, at the recipient, if the recipient attempts to retrieve the electronic mail from the local storage: (the server than retrieves the encrypted data from the secure database, decrypts the retrieved data: Spraggs: column 3, lines 46-64; figure 7)

Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Spraggs’s ideas of including into a server with abilities of re-encrypting received data from sending client for storing them into a secure database, and then decrypting the stored encrypted data from the secure database for forwarding to the receiving client into Chaudhari-Leonard’s system in order to increase security level for email transmission system and further increase flexibility for the email system e.g. do not require keys exchanging between communication elements, see (column 1, lines 12-14, 44-48)

**Regarding claim 17:**

This claim is rejected under rationale of claim 1

**Regarding claim 6:**

Chaudhari discloses the invention substantially as claimed, including an electronic mail confidentiality preserver of a recipient email client, comprising:

confidentiality levels for email recipients: (Chaudhari discloses method for establishing confidential levels for email recipients so that the mailing system can be able to calculate/ and determine if the recipients are authorized to read the emails stored from the secured database based on assigned confidential levels: column 5, lines 1-67; column 8, lines 1-40; column 9, lines 32-34)

However Chaudhari does not explicitly disclose encryption/decryption engine couple to the input-processing engine

In analogous art, Leonard discloses three tiers communication system including: sending terminal (3), central E-Mail server (10), and email receiving terminal (13). In Leonard secure mail delivery system, the sending terminal and central E-Mail server interoperate to each other for recreating encrypting and setting-up read-only mode for sending email to limit recipient to manipulate/ and take any action on the received email; logically, the encryption/decryption engine, and input-processing engine should be included in those systems, see (figure 6)

an input-processing engine to limit abilities of a user of the recipient email client to manipulate contents of an electronic mail received by the recipient email client: (Leonard disclosed the sender can permit/ or limit viewer to manipulate messages e.g. forwarding, printing: figure 5, items 330; figure 14, items 27, 29; column 11, lines 25-29; column 12, lines 25-40; column 9, lines 46-50)

Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Leonard's ideas of limiting mail viewers to manipulate messages e.g. forwarding, printing into Chaudhari's's system in order to increase secure level for privacy information protection from mailing system, see (column 4, lines 50-67)

However, Chaudhari-Leonard does not explicitly disclose encrypt the electronic mail with authentication identity information if the recipient attempts to store the electronic mail to a local storage

In comparable art, Spraggs discloses “a server” which is equivalent in functionality with the recipient as claimed receives encrypted “data” which is equivalent to electronic mail as claimed from the sending client, and re-encrypts the decrypted data for storing in secure database, see (column 3, lines 45-50; figure 6)

Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Spraggs’s ideas of including into server with abilities of re-encrypting received data from sending client for storing them into a secure database, and then decrypting the stored encrypted data from the secure database for forwarding to the receiving client into Chaudhari-Leonard’s system in order to increase security level for data transmission system and further increase flexibility for the system e.g. the system do not require keys exchanging between communication elements, see (column 1, lines 12-14, 44-48)

**Regarding claim 11:**

Chaudhari-Leonard-Spraggs discloses a method as discuss in claim 6, which includes user interface: (receiving terminal includes monitor/ user interface: Leonard figure 6, item 13)

communication engine: (“viewer applet” which equivalent to “communication engine” as claimed: Leonard: figure 6, item 11)

a local storage: (Leonard disclosed a local storage for encrypted files: figure 6, item 12)



an electronic mail confidentiality preserver couple to the user interface, coupled to the communication engine and coupled to the local storage: ( a confidentiality preserver should be included in Chaudhari's system, and coupled to recipient terminal interface in order to be able to receive recipient's passwords and ids for calculating recipient's confidential levels to determine emails access levels from secured database: Chaudhari: column 8, lines 35-45)

**Regarding claim 4:**

In addition to rejection in claim 1, Chaudhari-Leonard-Spraggs further discloses asserting a control signal to disable options that are originally supported by the recipient if the confidentiality level satisfies a predefined confidentiality threshold: (Chaudhari discloses calculating recipient's confidential levels to determine emails access levels from secured database: column 8, lines 35-45)

**Regarding claim 5:**

In addition to rejection in claim 4, Chaudhari-Leonard-Spraggs further discloses the control signal is confidentiality-level-depend control signal: (in Chaudhari's system, "received recipient's passwords and ids" which is equivalent to "confidentiality-level-depend control signal" as claimed used for calculating recipient's confidential levels to determine emails access levels from secured database: column 1, lines 8-16; column 2, lines 44-67; column 8, lines 35-45)

**Regarding claims 7 and 20:**

Those claims are rejected under rationale of claim 4

**Regarding claims 8 and 21:**

Those claims are rejected under rationale of claim 5

**Regarding claim 16:**

This claim is rejected under rationale of claim 11

**Claims 2-3, 9-10, 15, 18-19 are rejected under 35 U.S.C 103(a) as being unpatentable over Chaudhari-Leonard-Spraggs in view of Al-Salqan (U.S. 6,775,382)**

**Regarding claim 2:**

Chaudhari-Leonard-Spraggs s discloses the invention substantially as disclosed in claim 1, but does not explicitly teach where the identity information is a system password

In analogous art, Al-Salqan discloses receiver is prompted for a password corresponding to private key, see (column 6, lines 32-50; column 3, lines 1-14)

Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Al-Salqan's ideas of corresponding prompting passwords to private keys into Chaudhari-Leonard-Spraggs's system in order to increase conveniences for secure messages transmission system users e.g. receivers still be able to decrypt encrypted messages in the case they loss their private keys, see (column 2, lines 37-59)

**Regarding claim 3:**

Chaudhari-Leonard-Spraggs discloses the invention substantially as disclosed in claim 1, but does not explicitly teach

prompting a user of the recipient to supply the identification: (Salqan: column 6, lines 32-50)

decrypting the electronic mail with the identification supplied by the user: (in Salqan's column 6, lines 32-50)

**Regarding claim 9:**

Chaudhari-Leonard-Spraggs discloses the invention substantially as disclosed in claim 6, but does not explicitly teach asserting a second signal to invoke the encryption/decryption engine in response to the user's access

In analogous art, Al-Salqan discloses a receiver is prompted for "a password corresponding to private key" which shares functionality with "a second signal" as claimed to invoke decryption engine processes decrypting encrypted message, see (column 6, lines 32-50; column 3, lines 1-14)

Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Al-Salqan's ideas of corresponding prompting passwords to private keys into Chaudhari-Leonard-Spraggs's system in order to increase conveniences for secure messages transmission system users e.g. receivers still be able to decrypt encrypted messages in the case they loss their private keys, see (column 2, lines 37-59)

**Regarding claims 10 and 19:**

Those claims are rejected under rationale of claim 3

**Regarding claim 18:**

This claim is rejected under rationale of claim 2

**Regarding claim 15:**

This claim is rejected under rationale of claim 9

**Claims 12-14 are rejected under 35 U.S.C 103(a) as being un-patentable over Chaudhari-Leonard-Spraggs in view of Bennett (U.S. 6,760,704) and further in view of Gupta et al. (U.S. 2001/0042098)**

**Regarding claim 12:**

Chaudhari-Leonard-Spraggs discloses the invention substantially as disclosed in claim 6, but does not explicitly teach a first set of confidential levels for the user to select

In analogous art, Bennett discloses user can prompt sensitive condition for message, see (column 10, lines 6-11)

However, Chaudhari-Leonard-Spraggs -Bennett does not explicitly disclose a second set of options to manipulate the electronic mail for the user to select

In analogous art, Gupta discloses interface provides various user-selectable options e.g. viewing, creating, and manipulating email, see( [0097]; [0085])

Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate Bennett's ideas of using prompting information for select confidentiality levels and Gupta's ideas of using interface providing various user-selectable options into Chaudhari-Leonard-Spraggs -Bennett's system in order to employ well-know technique into Chaudhari-Leonard-Spraggs -Bennett's system for saving resources and decrease development time

**Regarding claim 13:**

This claim is rejected under rationale of claim 4

**Regarding claim 14:**

This claim is rejected under rationale of claim 5

The prior arts made of records and not relied upon are considered pertinent to applicant's disclosure. The following patents and publications are cited to further show the state of the art with respect to "Method and apparatus for preserving confidentiality of electronic mail":

6766458; 20030046533; 6877137; 6766458; 6877137; 20020174185; 6304973; 7028049;

5940591; 2002/0144148; 7136906: column 4, lines 60-67; column 5, lines 1-9; 7136903;  
20020178353; 6567914; 6151675; 20020029275; 20010023483; 20020018566; 20020120837;  
71212969: figure 2; 20020055935; 7165174; 7020781

### Conclusions

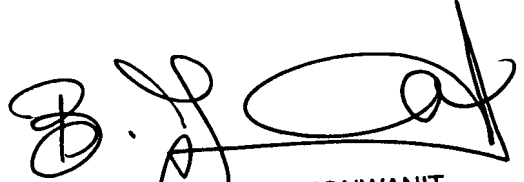
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lan-Dai Thi Truong whose telephone number is 571-272-7959.

The examiner can normally be reached on Monday- Friday from 8:30am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob A. Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

11/19/07

  
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11/26/07